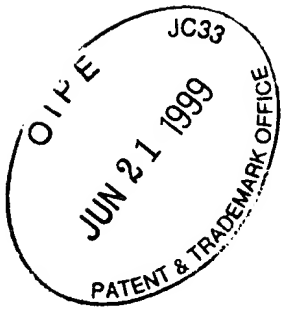
## REMARKS

Applicant has cancelled claims 3, 7, 12, 17 and 19. Thus, claims, 1, 2 4, 5, 6, 8, 9, 10, 11, 13, 14, 15, 16 and 18 remain in the case. These claims have all previously been rejected by the Examiner under 35 USC §101 as being directed to non statutory subject matter. Applicant has amended claims 1 and 11 which are the only two independent claims remaining in the case to avoid the section 101 rejection. Specifically, Applicant has set forth a pre-computer step of performing at least one set of pre-selected tasks before interacting with the computer and entering the data from the performance of such pre-selected tasks into the computer. Moreover, Applicant has also added to the independent claims a post computer step expressing the physical use of the resulting score to represent a final profit or determine a net recovery. Thus, it appears the rejections under 35 USC §101 have been overcome.

Rejection under 35 USC §103. All of the claims have been rejected by the Examiner under 35 USC §103 as being obvious over De Tore in view of Harbert T. Lewis "Patent Enforcement Aids Technology Transfer". The Applicant has amended the two independent claims from which all other claims depend to include the specific feature of a pre-computer step of performing at least one set of pre-selected tasks selected from the group consisting of technical orientation, technical review, preliminary assessment, patent study, market identification and analysis, industry intelligence, cost benefit analysis, marketing and licensing assessment. These pre-computer steps as taught by Applicant at pages 27 and 28 of the specification further define Applicant's invention and are not made obvious or even remotely suggested by the references cited by the Examiner. These completed tasks however, generate significant information frequently too voluminous to handle and assimulate into a risk determing procedure. Particularly patentable using a computer are those things which cannot be done or would not be done or would not be obvious to do without the superior calculating powers of the computer. It is a logical extension therefore, that the result is a new, useful and unobvious product. In this case, the end product is a final profit or a net recovery which is achieved in a rapid, efficient, low cost evaluation process of determining the risk associated with licensing or enforcing intellectual property. Clearly, this situation with its numerical result is identical to the situation upheld by the Court of Appeals in State Street Bank and Trust Company v. Signature Financial Group, Inc. 47 USPQ 2nd, 1596, 7/23/98. In that case, the court held:

> "Today we hold that the transformation of data representing discreet dollar amounts by a machine through a series of mathematical calculations into a final share price constitutes a practical application of a mathematical algorithm, formula or calculation because it produces a useful, concrete, intangible result, a final share price, momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities in subsequent trades."

Based upon the amendment to the claims and in consideration of the above Remarks Applicant believes this application is in condition for allowance and respectfully such action.




Respectfully Submitted,

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CERTIFICATE OF MAILING

I hereby certify that this Amendment of U.S. Serial No. 08/581,992 filed 1/02/96, Entitled: Method For Determining The Risk Associated With Licensing Or Enforcing Intellectual Property, is being deposited with the United States Postal Service with first class postage thereon in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on June 16, 1999.

Robert W. Fletcher